

1 THE HONORABLE BARBARA J. ROTHSTEIN
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8 **U.S DISTRICT COURT**
9 **WESTERN DISTRICT OF WASHINGTON**
10 **TACOMA**

11 GORDON HEMPTON,

12 Plaintiff,

13 v.

14 POND5 , INC., a Delaware Corporation; and
15 POND5 USER CKENNEDY342, a corporation
or individual of type unknown,

16 Defendants.

17 NO. 3:15-cv-05696-BJR

18 PLAINTIFF'S MOTION TO COMPEL
19 COMPLETE DISCOVERY RESPONSES
20 REGARDING POND5 CUSTOMERS
21 WHO DOWNLOADED PLAINTIFF'S
22 COPYRIGHTED WORKS

23 NOTE ON MOTION CALENDAR:
24 September 23, 2016

I. INTRODUCTION

Plaintiff Gordon Hempton (“Plaintiff” or “Mr. Hempton”) hereby moves this Court for an order compelling Defendant Pond5, Inc. (“Pond5”) to produce full and complete responses to Interrogatories No 1 and 3 and Requests for Production No. 7 and 16 provide information related to Pond5’s customers who purchased and downloaded Mr. Hempton’s copyrighted material from Pond5’s website. The parties have met and conferred on at least three occasions and Defendant has been unwilling to identify the customers. For the reasons below, Plaintiff’s motion should be granted.

In this action, Mr. Hempton, a nature sound recordist, alleges infringement of his copyrighted works by Pond5, an online merchant that distributes content to its customers. In his Complaint, Mr. Hempton alleges that Pond5 user ckennedy342, now understood to be Hassan Khan in Karachi Pakistan, uploaded hundreds of Mr. Hempton’s copyrighted audio files to Pond5’s online market and Pond5 offered these files for sale. Dkt. 1. Through discovery in this action, Plaintiff has confirmed that 1) ckennedy342 uploaded to Pond5, and Pond5 offered for sale, 655 tracks that are Mr. Hempton’s copyrighted works; and 2) 86 of those tracks were subsequently purchased and downloaded 146 times by Pond5 customers. Declaration of Gordon Hempton (“Hempton decl.”) at ¶ 5-8. Additionally, an unknown number of free “evaluation copies” of Mr. Hempton’s works were downloaded by Pond5 customers. *Id.* ¶ 16. Pond5 admits that it has taken no action with respect to the infringing copies of Mr. Hempton’s works.

Customers who purchase and download infringing content from Pond5.com are falsely told by Pond5 that they are purchasing a broad, royalty-free, world-wide license that allows them to use, copy, perform, reproduce, and create derivative works from that content with almost no restrictions. Dkt. 16 at 1.¹ Thus, the number of additional and continuing copyright infringements by each of these individuals and the potential damage to Mr. Hempton's copyrights from these 146 purchases of 86 tracks (and an unknown number of downloads of evaluation copies) is

¹ See also Deposition of Pond5 30(b)(6) representative Thomas Crary (“Crary Dep”) at 22-28, ex. 1 to Declaration of Roger Townsend (“Townsend decl.”).

1 uncontained. Until Pond5 reveals to Mr. Hempton the identities, contact information, and other
 2 documentation associated with the customers who purchased and downloaded his copyrighted
 3 works, Mr. Hempton has no ability to determine the extent of, or to mitigate, the infringement of
 4 and damage to his copyrights.

5 Plaintiff served discovery requests on Pond5 for information regarding Pond5's customers
 6 that downloaded Mr. Hempton's works. Ex. 2 to Townsend decl. At Pond5's request, Plaintiff
 7 has furnished Defendant with substantial proof that Pond5 distributed unauthorized copies of Mr.
 8 Hempton's copyrighted works. However, Defendant has refused to provide Plaintiff with any
 9 particularized information regarding to whom it actually distributed Mr. Hempton's works. The
 10 discovery sought is reasonably likely to lead to the discovery of admissible information, is readily
 11 accessible to Pond5, and should be compelled to be produced.

12 II. FACTS

13 A. Background Facts

14 Gordon Hempton is a pioneer in the recording of nature sounds. Complaint, dkt 1 at ¶¶ 11-
 15 34. He has spent a lifetime traveling to remote locations around the world to obtain the highest
 16 quality audio content. *Id.* Mr. Hempton has made his livelihood selling and licensing his
 17 recordings for use by various media producers, as well as in the growing mediation recording
 18 market. *Id.* Mr. Hempton has obtained copyright registrations on his recordings and maintains an
 19 exclusive ownership interest in his recordings. Complaint, dkt. 1, ¶¶ 38-41 and exhibits.

20 Defendant Pond5 operates an online marketplace that licenses media to customers. Dkt 12,
 21 ¶ 9. Third party contributors submit videos, photos or sound effects to Pond5 and Pond5 posts the
 22 media for sale. *Id.* Pond5 conducts curatorial review for suitability on the Pond5 system and, if
 23 accepted, posts to the content for sale to its customers. When a file is sold, Pond5 keeps 50% of
 24 the sale proceeds. *Id.*

25 Pond5 customers who do not purchase content can nonetheless download an "evaluation
 26 copy." Crary dep. at 35-36; 268-274. The evaluation copies contain an "audio watermark" of a
 27 voice saying "Pond5" or "Pond5.com" approximately every 7 to 9 seconds. Dkt. 12 at 33. Due to

1 the nature of Mr. Hempton's works (i.e., nature sounds without a narrative structure), the
 2 evaluation copies can be edited and exploited as independent economically viable copies. Pond5
 3 admitted that it tracks who downloads these evaluation licenses, but has refused to produce any
 4 information regarding the end users. In fact, Pond5 has testified that it has not even bothered to
 5 look at its own data about who downloaded Mr. Hempton's works on either a paid or evaluation
 6 basis. *Id.* at 37, 270-71.

7 **B. Plaintiff's Request for Information regarding the Scope of Infringement of**
Plaintiff's Works

8 Plaintiff alleges that Pond5 allowed a repeat infringer, ckennedy342/Hassan Khan, to get
 9 through its curatorial review and upload over ten thousand files to Pond5's site. Hempton decl. ¶
 10 5-8. Pond5's CFO initially acknowledged that some of ckennedy342's uploaded files were Mr.
 11 Hempton's and apologized that it had sold Mr. Hempton's works without his permission.²

12 Despite this acknowledgement, Pond5 has subsequently adopted the position that it would
 13 be speculative to conclude that ckennedy342's uploaded files were the same as Mr. Hempton's.
 14 In response, Mr. Hempton has diligently provided information supporting the conclusion that was
 15 obvious from the outset: the files distributed by Pond5 are identical to Mr. Hempton's copyrighted
 16 works. At this time, there is no legitimate dispute that the files are the same.³

17 Pond5 has had copies of Mr. Hempton's copyrighted works since February 5, 2016, prior
 18 to Pond5 propounding any discovery requests in this case. On that date, Plaintiff produced a copy
 19 of the files from his copyrights attached to the complaint, with an accompanying index including
 20 the title of each audio file. (HEMP 000001-69.) Subsequently, pursuant to an informal request
 21 from Pond5, Plaintiff produced to Pond5 copies of the works in individual smaller segments. *See*
 22 ex. 5 to Townsend decl.

23 On April 28, 2016, Pond5 produced to Mr. Hempton the sound files uploaded by
 24 ckennedy342 and offered for sale on Pond5.com. The files are identical to Mr. Hempton's. In

26 ² See October 16, 2015 Email from Crary to Mr. Hempton (PON 000284-293), ex. 4 to Townsend decl.

27 ³ See Hempton decl. and exhibits.

1 addition to sounding identical to the naked ear, the files are the same length, contain nearly
 2 identical titles of files (e.g., “Insect crickets isolated” and “insect-crickets-isolated”), and the
 3 “audio thumbprints” are the same. Hempton decl. at ¶ 7. Additionally, the metadata associated
 4 with the files uploaded by ckennedy342 demonstrate that more than 100 files contained Mr.
 5 Hempton’s exact Quiet Planet catalog name and number in the metadata. *See* ex. 6 (Email from
 6 Pond5 attaching spreadsheet, PON00539). Based on his detailed and technical analysis, Mr.
 7 Hempton has concluded that 655 of the files uploaded by ckennedy342 are Mr. Hempton’s, and
 8 that 86 of those files were purchased and downloaded by Pond5 customers 146 times. *See*
 9 Hempton decl.⁴

10 **C. Plaintiff’s Discovery Requests**

11 On December 10, 2015, Plaintiff served Plaintiff’s First Set of Interrogatories and
 12 Requests for Production. Ex. 2. Plaintiff made the following requests related to the identities of
 13 customers who downloaded Mr. Hempton’s works, and any efforts by Pond5 to contact those
 14 customers or recall Mr. Hempton’s works:

15 **INTERROGATORY NO. 1:** Identify all Customers who downloaded Gordon
 16 Hempton’s copyrighted works of authorship from January 1, 2012 to the
 17 present. Identify and describe with particularity all efforts to recall Mr. Hempton’s
 18 material or otherwise respond to your knowledge that Mr. Hempton did not authorize
 19 the use of his works.

20 **REQUEST FOR PRODUCTION NO. 3:** Please provide a complete accounting of
 21 the history of Gordon Hempton’s copyrighted sound files on Pond5, including which
 22 files have been downloaded, when they were downloaded and/or purchased, who
 23 downloaded and/or purchased them (including name, username, IP addresses,
 24 identity, location, business for whom the Contributor was an agent, paypal username,
 25 paypal payment data information available to Pond5), as well as how much the
 26 Contributor paid to download each file.

27 **REQUEST FOR PRODUCTION NO. 7:** Please provide all documents and
 28 information received by Pond5 from any user who uploaded or downloaded Gordon
 29 Hempton’s works.

30 **REQUEST FOR PRODUCTION NO. 16:** Please produce all documents related to
 31 any efforts Pond5 has undertaken to contact Contributors who have downloaded
 32

33 ⁴ It is presently unknown by Plaintiff how many of his files and how many times his files were downloaded or
 34 reviewed as evaluation copies because Pond5 has not produced *any* information related to these discovery requests.

1 and/or purchased Gordon Hempton's works.

2 To date, Defendant has refused to furnish Plaintiff with the identities of Pond5's customers
 3 who downloaded Mr. Hempton's copyrighted audio files, and has refused to make any effort to
 4 recall Mr. Hempton's copyrighted works from those customers.

5 In other instances in which it becomes aware of infringement on its website, Pond5 has
 6 promptly reached out directly to its customer, requested that the customer "cease use of the track"
 7 and offered a settlement. *See* September 7, 2016 Pond 5 email to Customer, attached as Ex.8 to
 Townsend Decl.

8 Counsel for Plaintiff and Defendant have conferred repeatedly, in writing, face to face, and
 9 by telephone and have not been able to come to resolution. *See* Townsend decl. ¶ 9. This motion
 10 comes on the Court's instruction after the parties contacted the Court for a discovery conference.
 11 Dkt. 32.

12 **D. Plaintiff's Motion to Amend**

13 Contemporaneous with this Motion, Plaintiff has moved to amend his Complaint and seeks
 14 to add as "John/Jane Doe" defendants the Pond5 customers who purchased or otherwise
 15 downloaded Mr. Hempton's property from Pond5. But regardless of whether the Pond5
 16 customers are added as defendants, their identities and contact information are reasonably likely to
 17 lead to the discovery of admissible evidence and should be produced.

18 **III. ARGUMENT**

19 Plaintiff respectfully requests that his motion to compel be granted. The identities, contact
 20 information, and other records related to the Pond5 customers who purchased infringed versions
 21 of Mr. Hempton's copyrighted works on Pond5.com are discoverable and should be promptly
 22 produced.

23 **A. The Information Sought is Relevant, Proportional and Discoverable**

24 FRCP 26(b)(1) provides that:

25 Unless otherwise limited by court order, the scope of discovery is as follows:
 26 Parties may obtain discovery regarding any nonprivileged matter that is relevant
 27 to any party's claim or defense and proportional to the needs of the case,
 considering the amount in controversy, the importance of the issues at stake in the

1 action, the parties' resources, the importance of the discovery in resolving the
 2 issues, and whether the burden or expense of the proposed discovery outweighs
 3 its likely benefit. Information within this scope of discovery need not be
 4 admissible in evidence to be discoverable.

5 The identity of the Pond5 customers who purchased and downloaded Mr. Hempton's work
 6 is directly relevant to liability in this case. To prove copyright infringement, it is sufficient to
 7 show (1) plaintiff's ownership of the copyright and (2) defendant's unauthorized copying of
 8 protected material. *See, e.g., North Coast Indus. v. Jason Maxwell, Inc.*, 972 F.2d 1031, 1033 (9th
 9 Cir.1992); *Krofft Television Prods. v. McDonald's*, 562 F.2d 1157, 1162 (9th Cir. 1977). In his
 10 Complaint, Plaintiff alleged copyright infringement and named as defendants Pond5 and Pond5
 11 contributor ckennedy342. Through discovery in this action and after more than 100 hours of
 12 meticulous file-by-file comparison, Plaintiff has confirmed that 1) ckennedy342 uploaded to
 13 Pond5, and Pond5 offered for sale, 655 tracks that are Mr. Hempton's copyrighted works; and 2)
 14 86 of those tracks were subsequently purchased and downloaded by Pond5 users 146 times. *See*
 15 Hempton decl. at ¶¶ 5-8 and exhibits.

16 The Western District of Washington has a precedent of requiring production of
 17 information related to direct infringers. In *LHF Prods. v. Does 1-15*, 2016 U.S. Dist. LEXIS
 18 111056 (W.D.WA 2016), the Court denied a motion to quash a subpoena identifying the users
 19 who illegally downloaded a copyrighted motion picture, reasoning that,

20 The Court agrees with Plaintiff and cited cases in this district and beyond—Defendants are
 21 not entitled to anonymity. Each subscriber's identity is relevant and almost certainly
 22 necessary to determine the identity of the actual infringer. The burdens described in
 23 Defendants' Motions are not unique to this case and would befall any Defendant to a
 24 lawsuit. Furthermore, the Court is convinced that the requested information cannot be
 25 obtained from some other source that is more convenient, less burdensome, or less
 26 expensive.

27 *Id.* at *5.⁵ In *A & M Records, Inc. V. Napster, Inc.* 239 F.3d 1004 (2001), the Ninth Circuit

28 ⁵ *See also Cybermedia*, 19 F.Supp.2d at 1079 (collecting cases requiring recall of third-parties' distribution of
 29 infringing products); *Homeland Housewares, LLC v. Euro-Pro Operating LLC*, 2014 U.S. Dist. LEXIS 127250
 30 (C.D.Ca 2014) (denying defendant's motion to enjoin plaintiff from sending letters to retailers who carry defendant's
 31 allegedly infringing product); *On Command Video Corp. v. Columbia Pictures*, 764 F. Supp. 1372, 1373 (N.D. Cal.
 32 1991) (recognizing that courts routinely uphold good faith notifications to non-parties of pending intellectual property
 33 claims, and that notification is prohibited only where alleged infringer can demonstrate bad faith).

1 recognized that users who downloaded files containing copyrighted music violated the plaintiffs' 2 reproduction rights and consequently could be liable as direct infringers. *Id.* at 1014-1015. 3 Further, the Copyright Act is a strict liability statute. So while the downloaders may have (or may 4 not have) been unwitting in their infringing activity, a lack of intent does not absolve an infringing 5 party of liability. *See Cybermedia v. Symantec Corp.*, 19 F.Supp.2d 1070, 1079 (N.D.Cal. 1998). 6 Plaintiff has a vital interest in discerning – and it is directly relevant to his claim – who the other 7 potential infringers are, the extent of their infringement, and what relationship those infringers 8 have to Pond5 and ckennedy342. Moreover, the identities of the customers are even more relevant 9 to Plaintiff in determining the additional potential defendants in this action because Pond5, in its 10 License Agreement, does *not* indemnify or hold harmless its customers in the event that Pond5 has 11 sold to the customer infringing content. *See* Crary dep. at 218; *see also* License Agreement at § 9, 12 ex. 3 to Townsend decl. Pond5 cannot dispute that, by its own License Agreement, direct liability 13 for infringement *does not* stop at Pond5. Each unauthorized reproduction, copying, and use of 14 Plaintiff's copyrighted works is an additional act of infringement.⁶

15 The information sought is also relevant to mitigation and damages. In a copyright 16 infringement claim, one measure of damages is actual damages. 17 U.S.C. § 504(b). This entails 17 proving “the extent to which infringement has injured or destroyed the market value of the 18 copyrighted work at the time of infringement.” 5-14 Nimmer on Copyright § 14.02. Disclosure of 19 the customers’ identities and documents related to those customers is necessary for Plaintiff to 20 investigate and evaluate the extent of his actual damages. Mr. Hempton is entitled to know what 21 Pond5’s customers did with the infringing material and the extent of the ongoing damage to 22 Plaintiff’s copyrights from these uses.

23 Pond5 proudly touts that it grants to its customers a royalty-free, worldwide, nearly- 24 unlimited license to the content its users purchase and download on Pond5.com.⁷ Pond5 has 25

26⁶ In an accompanying motion, Plaintiff seeks leave to amend his Complaint to name as defendants these “John/Jane Doe” Pond5 customers.

27⁷ *See e.g.* Pond5 FAQs (“Our license grants you lifetime, unlimited, worldwide usage, in perpetuity, across all media platforms”), available at <https://help.pond5.com/hc/en-us/articles/200944303-Is-My-Usage-Covered-by-Your>

1 falsely told its customers that Mr. Hempton's works could be used anywhere: in a commercial,
 2 movie, or in an ambient-sound app available for download. The infringing content which Pond5
 3 sold not only potentially deprived Mr. Hempton of a sale, but the content could now be being used
 4 to compete directly with products offered directly by Hempton.⁸ But Mr. Hempton has no way of
 5 discerning this until he obtains the identities of the downloaders. The identities of the downloaders
 6 is necessary to help Plaintiff prevent further downstream infringements from occurring and to
 7 mitigate his damages. *See Antman v. Uber Techs., Inc.*, 2016 U.S. Dist. LEXIS 5032, at *13-15
 8 (N.D. Cal. 2016) (“As a general rule... where the identity of an alleged wrongdoer is not known
 9 before a complaint is filed, a party “should be given an opportunity through discovery to identify
 10 the unknown defendants, unless it is clear that discovery would not uncover the identities...”).

11 Plaintiff's request for discovery does not overstep the bounds of and is proportional to the
 12 needs of the case. It is readily available to Pond5 which of its customers downloaded. In fact,
 13 Pond5 has a track record of reaching out to customers directly and requesting that they “cease use
 14 of the track” and offered a settlement.

15 **B. Plaintiff Need Not First “Prove” Liability**

16 Pond5 has taken the position in response to Plaintiff's discovery request and in discovery
 17 conferences with Plaintiff that Plaintiff must first conclusively “prove” his case – that the audio
 18 files uploaded by ckennedy342 and sold on Pond5.com were Mr. Hempton's copyrighted works –
 19 before he is entitled to the identity of the downloaders.

20 While Mr. Hempton disputes this onerous burden is required, he has nonetheless
 21 effectively met that burden. Plaintiff has proffered to Pond5 copies of all of his sounds files,
 22 including their titles, and where applicable, the Quiet Planet catalog numbers and names. Plaintiff
 23 has produced for Pond5 a title-by-title list comparing the ckennedy342 tracks to Plaintiff's tracks.

24 License-Agreement-.

25 ⁸ Among the other restrictions that Plaintiff includes in the licensing of his own content, Mr. Hempton expressly
 26 prohibits use of his content in ways that directly compete with Mr. Hempton's own commercially-lucrative use of his
 27 copyrighted works. *See e.g.* ex. 7 to Townsend decl. (HEMP 0001982, “prohibited uses”). Pond5 customers, who are
 granted an unlimited license, could be actively competing directly with Mr. Hempton's own use of his copyrighted
 works and undermining his tightly-controlled licensing.

1 Plaintiff has also proffered to Pond5 a wave form display analysis of all 86 purchased files and a
 2 spectrum analysis of a sample of these files which shows that the files' "audio thumbprints" are
 3 exact matches.

4 In any event, Pond5 is incorrect as a matter of law that Plaintiff must definitively prove his
 5 case before he is entitled to the discovery he seeks. The discovery rules simply require that the
 6 information be reasonably likely to lead to discovery of admissible evidence. Fed.R.Civ.P.
 7 26(b)(1). Notably, courts have upheld plaintiffs' right to send notifications to non-parties of
 8 pending intellectual property claims while a matter is pending, *before liability has been
 9 established*. See e.g. *On Command Video Corp.*, 764 F. Supp. at 1373 (recognizing that courts
 10 routinely uphold good faith notifications to non-parties of pending intellectual property claims,
 11 and that such notification is prohibited only where the alleged infringer can demonstrate bad faith
 12 by the alleged rights holder); *see also Sony Music Entm't Inc. v. Doe*, 326 F. Supp. 2d 556, 565
 13 (S.D.N.Y. 2004)(denying motion to quash subpoena where "Defendants have failed to refute in
 14 any way plaintiffs' allegations of ownership.").

15 **C. The Safe Harbor Defense Is Irrelevant to the Motion at Bar**

16 Lastly, Mr. Hempton is entitled to discover the identity of the purchasers and downloaders
 17 of his copyrighted works even in the event that this Court agrees with Pond5 that it is entitled to a
 18 safe harbor defense pursuant to 17 U.S.C §512(c). Such a finding would not render discovery of
 19 the identity of the end-users moot or indemnify Pond5's customers. 17 U.S.C. § 512(j) ("The
 20 following rules shall apply in the case of any application for an injunction under section 502
 21 against a service provider that is not subject to monetary remedies under this section..."). *See also*
 22 Section 412-B Nimmer on Copyright § 12B.11 ("the Online Copyright Infringement Liability
 23 Limitation Act ...creates something that falls slightly short of being a complete exemption... a
 24 party who qualifies may still be subject to injunction.").

25 In fact, Pond5's delay in remedial action undermines its Safe Harbor claim. In order to
 26 avail itself of a safe harbor defense, a defendant must demonstrate that they have moved
 27 expeditiously to remove the infringing content. The fact that Pond5 has taken no steps to recall the

1 files of Mr. Hempton's that it sold makes it clear that if such is to be done, it must be done by Mr.
2 Hempton himself. Mr. Hempton is entitled to learn where his files have gone so that he might
3 take steps to ensure that further infringement does not occur.

4 **IV. CONCLUSION**

5 For the above reasons, Plaintiff requests that the Court grant the instant Motion to Compel
6 and order Defendant Pond5 to respond Plaintiff's discovery requests related to the identity and
7 related documents concerning the Pond5 users who downloaded Mr. Hempton's copyrighted
8 works.

9 Signed this 8th day of September 2016.

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CERTIFICATE OF SERVICE

I hereby certify that on September 8, 2016, I electronically filed the foregoing document with the Clerk of the Court using the CM/ECF system which will send notification of such filing to all counsel of record.

/s/ Jamie Telegin
Jamie Telegin, Legal Assistant